

off-site service provider.

41. The computer-readable storage medium of claim 36, wherein the storage medium comprises a portable storage device.

42. The computer-readable storage medium of claim 36, wherein the storage medium comprises a memory of a computer.

REMARKS

Claims 13 and 19-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,946,659 ("Lancelot"). Claims 22-29 stand rejected under 35 U.S.C. § 102(a) as being anticipated by MedicaLogic's "Logician" application and related products, as disclosed in the following references: four MedicaLogic press releases respectively dated January 27, 1997, February 17, 1997, October 27, 1997, and November 10, 1997; Lynne Dunbrack, "Practice-Management Market to Reach \$1 Billion by 1999," Health Management Technology, June 1996, 31-34 ("Dunbrack"); and Ellen Messmer, "MedicaLogic Readies Distributed Patient Information Software," Network World, June 5, 1995, 37 ("Messmer"). Claims 14-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lancelot in view of U.S. Patent No. 5,146,439 ("Jachmann"). Finally, claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lancelot in view of Jachmann and Mary K. Kerrigan, "A New Profit Center," Computers in Healthcare, Dec. 1987, 33-36 ("Kerrigan").

More than a year ago, the Applicant was faced with -- and overcame -- the exact same rejections based on the exact same prior art. Office Action, Apr. 12, 2000, 6-17 (rejecting claims 13-29); Response to Office Action, Aug. 14, 2000, 9-11 (traversing rejection of claims 13-29); Office Action, May 8, 2001, 3 (stating that claims 13-29 were allowable). The only remaining issue in this case was whether claims 1-12 recited patentable subject matter under 35 U.S.C. § 101. Advisory Action, June 15, 2001. To avoid delaying allowance of claims 13-29 due to the issue concerning claims 1-12, the Applicant canceled the latter claims without prejudice. Second Response to Final Office Action, July 3, 2001. In view of these events, the Applicant was, to say

the least, surprised to receive the office action of July 25, 2001 resurrecting the previously-traversed rejection of claims 13-29. Indeed, the Examiner offers no explanation why the arguments previously accepted by the Office are now deemed to be insufficient to traverse the rejections.

In the hope of bringing this unusually-circuitous prosecution to an expeditious close, the Applicant has canceled claims 13-29, without prejudice, and has added new claims 30-42 in an effort to more clearly recite the subject matter of the claimed invention. The claimed invention is directed to automating administration of physician transcriptions -- a task which accounts for a substantial portion of the administrative workload in a typical medical practice. By contrast, the prior art cited by the Examiner relates to computer-based systems for creating, maintaining and distributing clinical information in the form of electronic medical records, or EMRs. None of that prior art teaches or suggests automating the administration of transcriptions as recited in the pending claims. The Applicant therefore respectfully submits that each of the pending claims 30-42 is patentably distinguishable over the prior art of record, and respectfully requests early notice to that effect.

While frustrated with having to revisit rejections that the Office previously withdrew, the Applicant understands that a thorough examination of the present application is in the best interests of all concerned. Accordingly, in the event the Examiner finds the foregoing unpersuasive, the Applicant respectfully requests the opportunity to meet with the Examiner prior to the issuance of any final rejection. The inventor, Dr. Geoffrey Miller, would welcome the opportunity to explain to the Examiner the substantial differences between his invention and the prior art of record. Should the Examiner believe such an interview would be useful, he is requested to contact the undersigned so that Dr. Miller can make arrangements to travel here from California.

The Applicant invites the Examiner to contact the undersigned to discuss any matter concerning this application. The Applicant hereby authorizes the Office to charge any fees or credit any overpayments arising from this communication to Kenyon & Kenyon's Deposit Account No. 11-0600.

Respectfully submitted,

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